

## **REMARKS/ARGUMENTS**

Claims 1-3, 6-17, 19, 21-52 are pending.

Claims 4-5, 18 and 20 have been cancelled.

Claims 2, 6-7, 32-33, and 36-49 have been withdrawn from consideration.

Claims 1, 3, 8-17, 19, 21-31, 34-35, and 50-52 are rejected.

### **Claim Rejections – 35 U.S.C. § 102/103**

Claims 1, 3, 8-12, 16-17, 19, 21-23, 25-31, 34-35 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Bondoc et al. (U.S. Patent No. 6,105,329) as in the action dated September 29, 2006. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc et al. in view of Elliott et al. (U.S. Patent No. 6,421,976) and Stahl et al. (U.S. Patent No. 6,305,138) as in the action dated September 29, 2006. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of Stahl as in the action dated September 29, 2006. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of Elliott as in the action dated September 29, 2006. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc as in the action dated September 29, 2006. Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc as in the action dated September 29, 2006.

The Examiner alleges that Bondoc, individually or in combination, discloses or makes obvious at least each of the elements of independent claims 1, 8, 29, 34, 35, 50 and 52. Applicants respectfully disagree for the reasons pointed out below.

In order to distinguish the features of the invention, Applicant has amended independent claims 1, 8 and 50 to clarify that the shingle has an outermost bottom left and right corner, and

that at least one corner of the shingle corresponds to the alignment notch of the shingle. This feature is clearly taught in the specification on page 9 and in Figs. 1-14 and 22. Accordingly, Applicant respectfully submits that no new matter has been added by way of the amendment to independent claims 1, 8 and 50. Further, no new issue has been raised by way of the amendment since Applicant is merely clarifying the amendment made in the previous response to the Office Action, as discussed during the telephonic Examiner Interview on July 5, 2007. Therefore, Applicant respectfully requests entry of the amendment to the claims.

As seen in Figs. 5-8, the anterior headlap 13 includes at least one alignment notch 17 positioned along the lower edge of the anterior headlap 13. The alignment notch 17 can be formed using a shape that corresponds with an outermost left or right corner 20 of the shingle 10. Independent claims 1, 8 and 50 clearly recite that the shingle has an outermost bottom left or right corner (20) that corresponds with the alignment notch (17).

Bondoc, on the other hand, shows an anterior layer and a posterior layer, that when joined together to form a shingle (Fig. 3), has flat right angle edges on the bottom outermost left and right corners. These corners do not correspond with the alignment notch. Accordingly, Bondoc does not show this feature of claims 1, 8 and 50. The cited references of Stahl and Elliot further do not show this feature.

Further, Applicant has amended independent claims 29, 34, 35 and 52 to clarify that the fraction is a non-whole number. This feature is clearly taught in the specification on pages 13-14 and in Figs. 1-14 and 22. Accordingly, Applicant respectfully submits that no new matter has been added by way of the amendment to independent claims 29, 34, 35 and 52. Further, no new issue has been raised by way of the amendment since Applicant is merely clarifying the amendment made in the previous response to the Office Action, as discussed during the

telephonic Examiner Interview on July 5, 2007. Therefore, Applicant respectfully requests entry of the amendment to the claims.

Independent claim 29 claims a roofing shingle that comprises at least one layer formed from a cutting cylinder *having a circumference that is a fraction of the roofing shingle length, the fraction being a non-whole number*. Independent claims 34, 35 and 52 claim a two-layer composite roofing shingle having an anterior layer formed from a cutting cylinder *having a circumference that is a fraction of the two-layer composite roofing shingle length*. This feature is not taught by the cited references.

As set out in the specification on pages 13-14, the anterior layer 11 pattern is cut using a fractional cutting cylinder, where the fractional cutting cylinder produces a pattern that is a fraction of the shingle length. This provides a *substantially* repeating pattern. For example, if a fractional cutting cylinder circumference is 75% the length of a single shingle and that cutting cylinder includes a pattern, that pattern will be repeated every fourth shingle produced after the fifth rotation of the cutting cylinder. By utilizing a fractional cutting cylinder circumference, the maximum amount of patterns for the minimum amount of diameter can be produced.

During the telephonic interview, the Examiner stated that fractional design changes may be obvious to one of ordinary skill in the art. However, in the shingle manufacturing industry, each shingle produced by a cutting cylinder produces identical looking shingles. For a different shingle, a different cutting cylinder and different shingle rolls must be utilized. In the present invention, by using a fractional cutting cylinder, many different shingles with different front views can be produced. Therefore, when a fractional cutting cylinder of the present invention is used for cutting an anterior layer, each anterior layer of the roofing shingle will be different for a certain number of shingles.

For example, when a fractional cutting cylinder circumference is 75% the length of a single shingle and that cutting cylinder includes a pattern, then the pattern will be reproduced after every four shingles. Therefore, all four shingle will have different front views. For example, if such a fractional cutting cylinder was used to cut the anterior layer for the shingles in Figs. 5-8, after the anterior layer for the shingle in Fig. 5, the anterior layer in Fig. 8 would be produced, then the anterior layer in Fig. 7 would be produced, and then the anterior layer in Fig. 6 would be produced. After the anterior layer in Fig. 6, it would repeat, and the shingle in Fig. 5 would again be produced. Thus the pattern would repeat after four shingles were made, but after four *different anterior layers were fabricated* by the fractional cutting cylinder. By changing the fraction from 75% to another fraction, the maximum amount of patterns for the minimum amount of diameter can be produced. This is not possible in the prior art without changing the shingle roll or the cutting cylinder.

The Examiner, on page 6 of the Office Action, states that the phrase “formed from a cutting cylinder having a circumference that is a fraction of the roofing shingle length” are statements of the process of making the claimed invention. The Examiner further requires that the process must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. As shown above, this process clearly results in a structural different between the claimed invention and the prior art.

In Bondoc, the same shingle is produced using the cutting cylinder. Bondoc does not teach a fractional cutting cylinder where the fraction is a non-whole number. In Bondoc, the cutting cylinder would be the same as the shingle length to produce the same shingle over and over, as is known in the prior art. Claims 29, 34, 35 and 52 claim a roofing shingle having a layer formed from a cutting cylinder having a circumference that is a fraction of the roofing

shingle length; where the fraction is a non-whole number. This allows for a structural difference between the claimed invention and the prior art, as required by the Examiner. Accordingly, Applicants submit that Bondoc does not show this feature of claims 29, 34, 35 and 52, and that the cited references of Stahl and Elliot further do not show this feature.

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Accordingly, as Bondoc fails to teach the features of the independent claims as discussed above, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection of independent claims 1, 8, 29, 34, 35 and 52 is improper.

Further, it has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). For the reasons distinguishing independent claim 50 from above, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 50 is also improper.

With regard to the remaining dependent claims, since the dependent claims incorporate all the limitations of the independent claims and recite additional unique elements and/or limitations, these claims remain patentable because the cited references individually or in combination do not supply the elements with respect to the independent claims.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1, 3, 8-12, 16-17, 19, 21-23, 25-31, 34-35 and 52 as being allegedly anticipated by Bondoc. Further, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 13-15, 24, 50 and 51.

### Conclusion


In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. Accordingly, Applicants respectfully request allowance of claims 1, 3, 8-17, 19, 21-31, 34-35 and 50-52.

If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the number provided below.

Please charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 03-1250 (Ref. No. FDN-2797).

Respectfully submitted,

Date: 7/5/07

  
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